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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,583	03/29/2004	Jay S. Walker	03-068	2063
22927 7590 07/10/2007 WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905			EXAMINER SAGER, MARK ALAN	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 07/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/811,583	Applicant(s) WALKER ET AL.	
	Examiner M. A. Sager	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-17 and 33-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17, 33-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Allowable Subject Matter

1. The indicated allowability of claim 17 and 33-34 is withdrawn in view of the newly discovered reference(s) to Marnell. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

2. Claims 15-16, 46-47 and 51-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Piechowiak (5580309). This holding is maintained from prior action for cited claims, as amended, as restated herein. Response to Applicants' remarks is provided below and incorporated herein. Where first and second player may be same but also includes where first player is not second player, Piechowiak discloses a method teaching receiving a first input at a first gaming device includes any game input at game device such as spin/play or handle pull as conventional for slot/poker machine (3:57-59, 4:29-35, ref. 101), receiving a second input at a second gaming device where second gaming device may be same or another linked game device (2:25-35, 4:29-35, 101-108), generating, based on both the first and second input, a single outcome comprising a plurality of indicia, the symbols derived from the reels of the first and second game device such that generating the outcome is based directly on the first and second input (2:11-34, 3:57-59, 4:29-35, as conventional generation of outcome(s) from play of first and second game device, that may be same or different game devices) but also includes generating an outcome based on combined results from individual game device towards determining whether a feature is to be enabled (1:50-52, 3:5-21, steps 204-210). Where selecting a row and selecting a column within a grid is each selection of bet or win/pay line, Piechowiak discloses claimed method including a player selecting of a row of a grid and a player selecting a column of the grid as conventional selection of bet/win/pay line(s) in slot machine play (3:57-59, 4:29-35).

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3. Claims 15-16, 33-38, 42, 46-47 and 51-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Marnell (5393057). Where claim language includes or at least fails to preclude first player may be same as or different player and/or first device may be same as or different device (claim 35 and 52 limit scope, but remaining claims fail to preclude and thus includes first and second being same or different), Marnell discloses a electronic gaming device and method teaching receiving first and second input from first and second player at first and second gaming device (figs. 1-5), generating based on both first and second input a single outcome comprising a plurality of indicia in which the outcome comprises a plurality of symbols derived from the reels of the first and second gaming devices (2:35-3:9, 3:34-46, 62-66, 6:28-7:26, refs. 22, 22a, 22b, 23, 23a, 23b), receiving an indication of a first row of symbols from a first gaming device in which the first row of symbols comprises a set of symbols that are displayed in a horizontal band across a display screen of first gaming device (22a, 23a), receiving an indication of a second row of symbols from a second gaming device (22a, 23a), combining the first row and second row to form a two-dimensional grid of symbols comprising at least two rows (23a, 51a), determining a payline on the two-dimensional grid of symbols, the payline comprising a plurality of symbols in which the payline is not a row of the grid such as column, diagonal, four corners or other conventional bingo win patterns for those win patterns that is not a row or does not include a row (9:33-41), transmitting instruction to first gaming device to provide the payout (7:7-12), determining an outcome of a game obtained by first player playing the game via first device (sic), determining a second player associated with first player at least due to playing on a linked device (fig. 5), second player playing a second device having a display device wherein the second device is not the first device (fig. 1-5, esp. 2, 4-5), outputting on the display an indication

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of the outcome obtained by first player (6:1-8, 6:28-7:26, refs. 22, 22a, 22b, 23, 23a, 23b, 66, 66a, 67, 67a), wherein first player is playing first device at substantially same time at which second player is playing second device (2:35-3:9, 3:34-46, 62-66, 6:28-7:26, figs. 1-5), wherein first and second device are in communication with a controller (ref 33, 69) and the controller determines that the outcome has been obtained via the first device and in response causes the second device to output the indication of the outcome via the display device (sic), determining an association between the players (sic), wherein the first input comprises first player selecting a row within a grid, wherein the second input comprises the second player selecting a column within the grid such as placement of outcome in cell which inherently includes row, column designation within two dimensional grid (2:35-3:9, 3:34-46, 62-66, 6:28-7:36, figs. 1-5, refs. 22, 28, 29, 22a, 28a, 29a, 22b, 28b, 29b, 51, 51a, 51b, 52, 52a, 52b, 53, 53a, 53b).

Claim Rejections - 35 USC § 103

4. Claims 35-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piechowiak in view of either Guinn (6039648) or Marks (5755621) or Schneier (5768382) or Thacher (5083271). Piechowiak discloses players playing at linked gaming machines (101-108) in a process comprising all steps (sic) including determining an outcome of a game obtained by a first player playing the game via a first device includes game output at a gaming machine (1:50-52, 2:11-34, 3:57-59, 4:14-35), the second player playing a second device having a display wherein the second device is not the first device (2:25-35, 4:29-35, ref 102-108), outputting an indication of the outcome obtained by the first player which includes the feature controller determining if the game result obtained from the first game machine enables a feature so as to provide indication of enablement of feature on each linked machine (3:1-26, ref 128, step 213), includes

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feature controller determining if game result obtained from first game machine wins an award during an enabled feature and thus after first game machine is awarded a prize, the feature is disabled (3:29-41, 54-57) and/or indication includes disabling the feature after a time period expires if no game result is obtained from first gaming machine for award to be won (1:51-56, 3:63-65, 4:14-35, fig. 1-2), wherein the playing the first device at substantially the same time at which playing the second device (sic), first and second device in communication with a controller and the controller determines outcome has been obtained and in response causes output of an indication via the display such as to display on gaming machine an indication of the outcome that the feature is enabled or disabled based upon feature controller determination (1:51-56, 2:11-3:65, 4:14-25, 29-35, fig. 1-2, ref. 202, 212, 213); however, Piechowiak lacks determining a second player associated with the first player, determining an association between the players, determining if the players are on a team together, determining if the players are on a team irrespective of position of the first and second gaming devices and detecting a representation from the players that they are on the team together, as claimed. However, team play in gaming devices is notoriously well known as demonstrated by Guinn (2:1-5, 45-51, 8:15-19) or Marks (16:14-15) or Schneier (23:9-55, 35:64-36:7, 47:18-24, 49:46-47, 52:45-46) or Thacher (18:29-36, fig. 1-2) that each teach team play by players on linked gaming machines that is implicitly based on player registering for team play in an electronic network of linked game devices for determining a second player associated with the first player, determining an association between the players, determining if the players are on a team together, determining if the players are on a team irrespective of position of the first and second gaming devices and detecting a representation from the players that they are on the team together, as claimed. It is

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further noted that Guinn, Marks, Schneier or Thacher each clearly teach selective linking of gaming machines by players indicating a desire to be linked in tournament or competitive play which is conventional selective network association. Some players enjoy competitive or tournament play as evidence by the saturation of tournaments or competitive play starting in elementary schools with sports or spelling bees through including professional sports (teamed or individual). Thus, it would have been obvious to an artisan at a time prior to the invention to add determining a second player associated with the first player, determining an association between the players, determining if the players are on a team together, determining if the players are on a team irrespective of position of the first and second gaming devices and detecting a representation from the players that they are on the team together as suggested/taught by Guinn or Marks or Schneier or Thacher to Piechowiak in order to permit players to register to compete in groups or as teamed players and to increase interest in linked progressive play thereby which increases revenue due to increased play.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Marnell or Piechowiak each in view of Okada (4773647). Where first game device and second game device may be same device, Marnell (6:48-49) and Piechowiak (4:29-35) each discloses apparatus and method comprising claimed steps (sic) including first input initializes the spinning of the reels of the first gaming device but does not clearly state including second input to halt the spinning of the reels of the first gaming device. Okada teaches stop button to halt the spinning of the reels of gaming device (abstract, 1:63-2:39) so as to permit player to halt spinning of reels (provides illusion of selection of indicia). Thus, it would have been obvious to an artisan at a time prior to

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the invention to add second input to halt the spinning of the reels of the first gaming device as taught by Okada to either Marnell or Piechowiak to permit player to stop spinning of reels.

6. Claims 35-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell in view of Guinn or Marks or Schneier or Thacher. Alternatively, Marnell discloses claimed method (*supra*) but lacks determining a second player associated with the first player, determining if the players are on a team together, determining if the players are on a team irrespective of position of the first and second gaming devices and detecting a representation from the players that they are on the team together, as claimed. However, team play in gaming devices is notoriously well known as demonstrated by Guinn (2:1-5, 45-51, 8:15-19) or Marks (16:14-15) or Schneier (23:9-55, 35:64-36:7, 47:18-24, 49:46-47, 52:45-46) or Thacher (18:29-36, fig. 1-2) that each teach team play by players on linked gaming machines that is implicitly based on player registering for team play in an electronic network of linked game devices for determining a second player associated with the first player, determining an association between the players, determining if the players are on a team together, determining if the players are on a team irrespective of position of the first and second gaming devices and detecting a representation from the players that they are on the team together, as claimed. It is further noted that Guinn, Marks, Schneier or Thacher each clearly teach selective linking of gaming machines by players indicating a desire to be linked in tournament or competitive play which is conventional selective network association. Some players enjoy competitive or tournament play as evidenced by the saturation of tournaments or competitive play starting in elementary schools with sports or spelling bees through including professional sports (teamed or individual). Thus, it would have been obvious to an artisan at a time prior to the invention to add determining a

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second player associated with the first player, determining an association between the players, determining if the players are on a team together, determining if the players are on a team irrespective of position of the first and second gaming devices and detecting a representation from the players that they are on the team together as suggested/taught by Guinn or Marks or Schneier or Thacher to Marnell in order to permit players to register and compete in groups or as teamed players and to increase interest in linked progressive play thereby which increases revenue due to increased play.

7. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell in view of Walker (6010404). Marnell discloses claimed method (supra) but does not clearly state including a seed number to be used in a random number generator for determining outcome. Walker discloses a method teaching including a seed number to be used in a random number generator for determining an outcome (abstract, 1:8-12, 2:13-28, 2:44-48, 3:10-17) to permit user illusion of control. Thus, it would have been obvious to an artisan at a time prior to invention to add including a seed number to be used in a random number generator for determining outcome as taught by Walker to Marnell to permit user illusion of control.

Response to Arguments

8. Applicant's arguments filed 4/26/07 have been fully considered but they are not persuasive. As stated in prior action, Applicant fails to consider breadth of claimed of invention and fails to consider conventional operation of game device or multiple game devices as demonstrated below. Also, although applicant may be his or her own lexicographer, in this instance, the applicant did not provide specificity to define scope of claim language defining invention in manner to preclude scope discussed in action.

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In reply to applicants remark that Piechowiak fails to teach generating a single outcome comprising a plurality of indicia, the examiner disagrees and notes applicant failure to consider breadth of claimed scope since the outcome generated by/at each gaming device includes a single outcome and the claim language 'comprising... a single outcome comprising a plurality of indicia' fails to preclude multiple outcomes generated from multiple game devices as conventional operation of each game device in that the claim language does not provide any distinction that precludes conventional operation as presently claimed. Stated differently, the multiple outcomes generated by Piechowiak's multiple linked machines include a single outcome comprising a plurality of indicia, as claimed.

In response to applicants assertion that patent office is stretching interpretation of claims with respect to based on both first input and second input, the examiner disagrees and notes that broadest reasonable interpretation of claim language that in this instance may include where the claim language does not specifically preclude such interpretation. The examples in specification are merely examples and do not limit scope of claimed invention. The applicant continues to improperly import disclosure into claims and thus is not persuasive. MPEP 2111.01.

In reply to applicants assertion that Piechowiak lacks direct causation, the examiner disagrees since Piechowiak teaches generating, based on both the first input and second input, a single outcome comprising a plurality of indicia as conventional game output (3:56-59) from each game device and notes only claim 51 presently is limited thereto. In response to Applicants statements that the Patent Office implicitly acknowledges the lack of direct causation, the applicants' misinterpretation is not persuasive since the action did not provide an implicit acknowledgement of a lack of direct causation as inferred by applicant and notes interview

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process was available, but no request had been made for clarification. The citation stated by Applicant from prior action as evidence of Patent Office acknowledgement pertained to the tabulation or counting of occurrences to enable a bonus feature taught by Piechowiak. However, the outcome generated by each game device (102-108) in Piechowiak is based directly on input from each player at each game device (sic) while the feature being enabled (step 213) or disabled (step 202) and displayed on display (128) is the indication on a display of an outcome at first game device. Thus, Piechowiak provides direct causation, as claimed; as does any two disparate game devices operating substantially same time. Also, Piechowiak's tracking of enabling criteria towards enablement includes a single outcome comprising a plurality of indicia (3:1-26).

In reply to applicant's remark regarding box-drawing exercise, the alluded box drawing is not office changing or redrawing scope of claims as asserted by counsel, but rather the Office is presenting the breadth of claimed scope and to demonstrate thereby how art anticipates claimed invention. Again, interview process was available but no request was made for clarification.

With respect to applicants remarks regarding outputting on the display device an indication of the outcome obtained by the first player at bottom page 11 to midway on page 12, the examiner maintains that claims do not preclude and in fact include first and second player being same player or may be different players, and/or that first and second game device may be same or different game devices at least since no distinction had been claimed to preclude (supra); however, presently claim 35 and 52 precludes and have been addressed accordingly in holding. Further, remark that this position strains credibility and stretches claim language is an incredible statement (in each of its occurrences). If applicant desires to preclude scope that presently is encompassed, amending to avoid is permitted and the stated scope of single player at multiple

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game devices or multiple players at single machine is conventional game play which if applicant disputes and requires, the examiner will provide affidavit upon request, if this is truly desired, but examiner does not see this as advancing prosecution since patentability does not lie within whether there is one or multiple players providing input at one or multiple machines. Regarding first and second being same or different, the examiner was providing an explanation of scope, but there was no indication therein of one form being patentable. In essence, the label 'first' and 'second' are not so defined by claim language or within written specification as to manner of distinguishing player or input or game device that defines/precludes either a temporal or location distinction. Also, the question posed in prior action pertaining to whether applicant believed Piechowiak did not require player input was relevant from point of view that applicant failed to consider (and continues to fail to consider) conventional operation of game device in that a conventional game device requires player input yet applicant omits its consideration being implicit in Piechowiak. Piechowiak teaches normal operation (3:56-59) which requires player input, yet applicant/counsel argue Piechowiak did not teach input by a player which is an incredible position to make; hence the Patent Office questioned whether applicant believed Piechowiak taught automated play that does not require player input. Thus the question was relevant to scope of claimed invention. Further, regarding outputting on display, the present claim language 'second device having a display device' and 'outputting on the display device an indication of the outcome obtained by the first player', the claim language does not preclude game device (101-108) and display (128) taught by Piechowiak anticipates breadth of claimed invention and fails to preclude the indication taught by Piechowiak as enablement/disablement displayed on display (128). Regarding applicants remark that the feature is displayed on display

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128, which is not a device on which the game is played, the examiner notes claim language does not require such an embodiment. As stated in prior action, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the display of indication is on a display device on which the game is played) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In particular, the claim includes in part 'player playing second device having a display device' and 'outputting on the display device an indication of the outcome obtained by the first player' and thus the claim requires a display but does not require that the display is a device on which game is played; although, Piechowiak game device includes a display device on which game is played (3:57-59, 4:29-35). In essence, claim language of 'player playing a gaming device having a display device' does not preclude additional display distinct from gaming device on which game is played taught by Piechowiak.

With regards to argument that Piechowiak does not teach an element of claim 15 or 35, the examiner disagrees and response above with respect to alluded missing element is incorporated herein. With respect to Applicants argument that there is no evidence to support the motivation to combine the references, the examiner disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of

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ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Piechowiak discloses steps of claimed method but lacks disclosing the teaming or association between players, as claimed. Guinn (2:1-5, 45-51, 8:15-19) or Marks (16:14-15) or Schneier (23:9-55, 35:64-36:7, 47:18-24, 49:46-47, 52:45-46) or Thacher (18:29-36, fig. 1-2) each teach team play by players on linked gaming machines that corresponds to selective network association that is implicitly based on player registering for team play in an electronic network of linked game devices for determining a second player associated with the first player, determining an association between the players, determining if the players are on a team together, determining if the players are on a team irrespective of position of the first and second gaming devices and detecting a representation from the players that they are on the team together, as claimed. It is further noted that Guinn, Marks, Schneier or Thacher each clearly teach selective linking of gaming machines by players indicating a desire to be linked in tournament or competitive play which is conventional selective network association. The motivation is derived from either within teachings of either Guinn or Marks or Schneier or Thacher or in the knowledge generally available to one of ordinary skill in the art to connect/associate players who desire to be linked in team play in a network of linked game devices that increases excitement from competition, increases camaraderie from team esprit de corps (as inherent from team and competition) and increases revenue for the casino from the increase in play. The skill level of the artisan is as demonstrated by the references of Piechowiak, Guinn, Marks, Schneier or Thacher which each teaches or implicitly discuss network association for team play. Thus, the combination taken as a whole at a time prior to invention suggests to an artisan, a method including determining a

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second player associated with the first player, determining an association between the players, determining if the players are on a team together, determining if the players are on a team irrespective of position of the first and second gaming devices and detecting a representation from the players that they are on the team together, as claimed, to permit players to register and play as associated or team members in competition or tournament play that increases excitement from the competition, provides camaraderie from team esprit de corps and increases revenue from increase play. Further, the issue regarding scoring discussed in remarks on page 14 is not relevant to claims and thus has been omitted in holding herein. Thus, Applicants statement that the references do not teach details of the claims is wrong since there is no claimed scoring.

9. Applicant's arguments with respect to claims 15-17 and 33-52 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

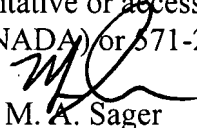
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hagiwara discloses selection of bet or win/pay line in slot machine.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



M. A. Sager
Primary Examiner
Art Unit 3714

mas